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7/15/05

In re Application of

Bednorz et al.

Serial Number: 08/479,810

Filed: June 7, 1995

For: New Superconductive Compounds Having High
Transition Temperature Methods For Their Use
And Preparation

This is a decision on the petition filed January 31, 2005, requesting that if the next action by the Examiner is not an allowance in response to Applicants' Amendment submitted January 28, 2005, Applicants' petition for a non-final office action providing the Examiner's reasons for why all of Applicants' arguments and evidence do not place Applicants' application in condition for allowance.

The petition is considered a timely submission under 37 CFR 1.181.

Issues:

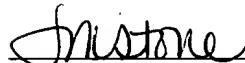
Applicants filed six supplemental responses. The last supplement response was on March 3, 2004. The examiner issued a non-final office action in response to the filed supplemental responses on July 28, 2004. Applicants assert that the Office action did not respond to all of Applicants' arguments and factual data as to why all of Applicants' claims are fully enabled.

Decision:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). A second or any subsequent action on the merits in an application should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations, which should reasonably have been expected to be claimed. See MPEP § 904 et seq.

The Examiner has not issued an Office Action in response to Applicants' reply. The request for relief under the filed petition is premature and not timely. A petition request on a premature final would be considered after the Examiner has issued a final action.

The petition is **DISMISSED**.



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